

REMARKS

Applicants gratefully acknowledge the withdrawal of the rejection of claims 16, 18-19 and 26 under 35 U.S.C. § 102(b) based on U.S. Patent No. 5,601,542 to Melius et al. ("Melius"), as well as the withdrawal of the rejection of claims 17, 24 and 25 under 35 U.S.C. § 103(a) based on U.S. Patent No. 5,601,542 to Melius as applied to claim 16, and (in the case of claims 24 and 25) further in view of U.S. Patent No. 3,875,942 to Roberts, et al. ("Roberts").

Claims 1-23 and 26-85 remain rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,891,120 to Chmielewski ("Chmielewski"). Claims 24 and 25 stand rejected under U.S.C. § 103(a) as being unpatentable over Chmielewski in view of Roberts.

Claims 1-85 remain pending in the application. Applicant respectfully requests reconsideration and allowance of each pending claim in view of the following remarks.

Rejection under 35 U.S.C. § 102(b) as anticipated by Chmielewski

Claims 1-23 and 26-85 are rejected under U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,891,120 to Chmielewski ("Chmielewski"). In the Office Action, the Examiner asserts that Chmielewski discloses the identical chemical structure of superabsorbent polymer as the claimed invention and that therefore the superabsorbent polymer of Chmielewski will inherently exhibit the same physical properties of the claimed superabsorbent polymer. Office Action, page 11. Applicants respectfully traverse for the following reasons.

First, Applicant respectfully submits that the chemical structure disclosed in the reference is not the same as the chemical structure of the presently claimed superabsorbent. In particular, the reference teaches that an "absorbent core 32 is

formed . . . from cellulosic fibers, such as wood pulp, and from distributed particles of a superabsorbent polymer (SAP) of a known type. See col. 4, ln 7-10. The reference further specifies that the "absorbent core has an absorbency under load (AUL) of not less than about 12 grams/gram along the elongate, central portion." See col. 4, ln 25-26. In contrast, the present claims recite the AUL value of the superabsorbent polymer rather than that of the entire absorbent core. Accordingly, the comparison of ranges is not appropriate because the AUL for the core does not correspond directly to the AUL for the polymer. In fact, where the range in the reference appears to overlap the claimed range, the subject matter should be disclosed in the reference with sufficient specificity. MPEP 2131.03.II (8<sup>th</sup> ed., Rev. 2). Here, the subject matter is not disclosed with sufficient specificity in view of the disclosure being referenced to the core, as well as the range being a broad, vague range (any AUL of 12 or greater) with no specific examples.

Secondly, Applicant respectfully submits that there is no extrinsic evidence of record to support the assertion of inherency. As provided in the MPEP, "[t]o serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." MPEP 2131.01.III (8<sup>th</sup> ed., rev. 2) (citing *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)). Here, there is no evidence that a superabsorbent polymer having an AUL value within the claimed range (even if the reference had disclosed such) will also necessarily have a Gel Integrity Index range within the claimed range. In the absence of such evidence, a *prima facie* case of inherent anticipation is not established. Moreover, Applicant notes that superabsorbent polymers are highly complex structures whose physical properties may vary largely dependent upon various characteristics, such as the amount of

crosslinking, for example, and thus they could differ from one another in a variety of ways while also sharing similar properties.

Further, Applicant's previous statement that "[p]ersons of ordinary skill in the art would be readily able to prepare and identify superabsorbent polymers meeting these characteristics . . ." does not indicate that the properties are inherent to certain polymers, contrary to the Examiner's assertion. See Office Action, page 11, lines 14-18. The statement to which the Examiner refers was actually a quote directly from the specification. In fact, the specification fully states that "Persons of ordinary skill in the art would be readily able to prepare and identify superabsorbent polymers meeting these characteristics, without undue experimentation, *based upon the guidance provided herein.*" See Specification, Page 8, lines 7-9. [emphasis added] Accordingly, it is only with the guidance provided in the specification that the claimed characteristics would be appreciated and selected from the multitude of possibilities. [In any case, for the cited reference to anticipate, the properties would have to be inherent in the polymers disclosed in the reference and, as stated above, there is simply no evidence of record that certain AUL properties inherently imply certain Gel Integrity Index properties.] Accordingly, Applicant did not merely select a "known element" because Applicant unexpectedly discovered the previously unappreciated benefits of the physical characteristics recited in the claims.

Finally, contrary to the Examiner's assertion that Applicant does not provide any argument as to why the identical superabsorbent polymer structures would not function in the same manner, Applicant respectfully submits that there is no evidence that the superabsorbent polymer disclosed in the reference is "identical" to the claimed polymer merely because of one particular feature, in view of the foregoing discussion. In fact, given the complexity of structure of the polymers, the evidence would suggest the opposite.

For at least the reasons provided above, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection and allow pending claims 1-23 and 26-85.

**Rejections under 35 U.S.C. § 103(a)**

To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2142. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicant respectfully submits that the burden of establishing a *prima facie* case of obviousness has not been met by the Examiner in this case. Moreover, even if a *prima facie* case of obviousness was established, it would be rebutted by secondary evidence of nonobviousness.

**Chmielewski in view of Roberts**

Claims 17, 24 and 25 are rejected under U.S.C. § 103(a) as being unpatentable over by U.S. Patent No. 5,891,120 to Chmielewski as applied to claim 16, and (in the case of claims 24 and 25) further in view of U.S. Patent No. 3,875,942 to Roberts, *et al.*

In view of the foregoing arguments, Applicant submits that Chmielewski is deficient for number of reasons, and in particular for failing to disclose an absorbent article comprising an absorbent article that has a GII of less than about 500 kg/mm, as recited by claim 16. Roberts fails to overcome the fundamental deficiency of the Chmielewski patent because it also fails to teach or suggest the recited physical

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properties of the superabsorbent. Therefore, the prior art references in combination do not teach or suggest all the claim limitations, and do not support a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw these rejections and allow the pending claims.

CONCLUSION

For at least the reasons outlined above, Applicant respectfully submits that the application is in condition for allowance. Favorable reconsideration and allowance of the pending claims are respectfully solicited. Should there be anything further required to place the application in better condition for allowance, Examiner Anderson is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,  
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